

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Lester F. Ludwig
Serial No: 09/812,400
Filed: March 19, 2001
For: PROCESSING AND GENERATION
OF CONTROL SIGNALS FOR REAL-TIME
CONTROL OF MUSIC SIGNAL
PROCESSING, MIXING, VIDEO, AND
LIGHTING

Art Unit: 2837
Examiner: Marlon T. Fletcher
Conf. Number: 7356

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated August 25, 2006, the three-month period for response having been extended to January 25, 2007, by virtue of the concurrent submission of a petition for a two-month time extension and payment of fees, Applicant requests review of the final rejection in the above-identified application.

Review of the application is requested for the reasons set forth below. No amendments are being filed with this request.

A Notice of Appeal is concurrently submitted herewith.

REMARKS

Claims 30-60 are all the claims pending in the application, claims 1-29 having been previously canceled. Claims 30, 40, 43, 46, 49, and 51-57 are independent claims. Claims 30-40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Suzuki (U.S. patent 5,981,859). Claim 41 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Lindemann et al. (U.S. patent 5,744,742). Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Clark Jr., et al. (U.S. patent 4,365,533) and Wallace et al. (U.S. patent 5,095,799). Claims 43-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Sgroi (U.S. patent 5,357,048). Applicant submits that there are a number of clear errors in the Examiner's rejections. Several of these errors will now be discussed.

First of all, the present application has languished at the USPTO for nearly 6 years, and has been subjected to 10 separate Office Actions (Office Actions issued: 1/23/02, 7/31/02, 3/12/03, 9/02/03, 3/29/04, 7/27/04, 1/13/05, 7/07/05, 1/11/06, 8/25/06). It is notable that only a single RCE has been filed (4/12/05). The vast majority of the Office Actions include a change in position by the Examiner, typically in the form of citing new references, and combinations of such references. Even more troubling is that issues that have been presented in earlier Office Actions (Sgroi purportedly teaching an "incoming MIDI signal"), and which have been resolved, have recently resurfaced in the latest-two Office Actions. See, e.g., the Office Action of 9/2/03, pg. 5. Another general area of concern, as the record clearly shows, is that the Examiner has failed to reply to, or even acknowledge, a number of significant comments with regard to the patentability of the claims. These issues, along with other matters, will be discussed in more detail below.

1. Event generator 11 does not generate MIDI signals

Claims 30-40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Suzuki. The Examiner recently clarified, for which Applicant is appreciative, that event generator 11 of Suzuki is being used to teach the independent claim 30 limitation of "an incoming control signal interface adapted to receive an incoming MIDI control signal." (Interview Summary of 7/12/06). The Examiner, in his latest comments, further alleges that event generator 11 generates or otherwise provides a MIDI control signal. *Id.*

However, Applicant has submitted substantial evidence that the Examiner's conclusion is misplaced; event generator 11 does not generate a MIDI control signal. (See, e.g., Response of 6/12/06, pg. 14; Applicant's Interview Summary of 7/19/06, pgs. 3-5). Indeed, Suzuki explicitly states

that event generator 11 generates a key-on/off event, but does not say anything about this key-on/off being MIDI. (See Suzuki at col. 3, lines 36-41). A key-on/off event is not the same thing as a MIDI control signal. Suzuki's disclosure supports Applicant's position, and provides absolutely no support for the position set forth by the Examiner. This reason alone conclusively supports a finding that claim 30 is patentable over the cited art.

2. No signaling flow from unit controller 13, or event generator 11, to generator 12

Claim 30 recites "a controllable low frequency oscillator comprising at least one parameter . . . wherein said value of said at least one parameter is determined by said incoming MIDI control signal," Applicant has demonstrated that the position set forth by the Examiner is absolutely inconsistent with the teachings of Suzuki. Applicant respectfully invites the Panel's attention to Fig. 2 of Suzuki. The latest rejection states that (a) tone color information generator 12 and unit controller 13 teach "at least one parameter;" and (b) event generator 11 teaches "said incoming MIDI control signal." (Office Action of 8/25/06, pg. 2).

Assuming *arguendo* that generator 12 teaches the claimed "at least one parameter," this parameter cannot be "determined by said incoming MIDI control signal" for the basic reason that there is no communication from generator 11 to generator 12. (See, e.g., Response of 6/12/06, pgs. 14 and 15; and Applicant's Interview Summary of 7/19/06, pgs. 6 and 7).

3. LFO 17 does not generate MIDI signals

Claim 30 further recites "wherein said controllable low frequency oscillator is adapted to generate an outgoing MIDI control signal." The Examiner has alleged, without requisite support, that LFO 17 of Suzuki provides the claimed "outgoing MIDI control signal." Applicant submitted comments which demonstrated that the outputs of LFOs 17 are directed to the musical tone waveform generator units (15-1 through 15-m), which in turn create outgoing musical tone outputs. The outgoing musical tone outputs of Suzuki are absolutely not MIDI. (Response of 6/12/06, pgs. 16 and 17). Applicant emphasizes to the Panel that none of the Office Actions of record identify the particular portions of Suzuki which indicate that LFO 17 generates an outgoing MIDI control signal. On this subject, the content of the latest Office Action falls short of the important requirements set forth in MPEP 707 and 37 CFR § 1.104(c)(2).

4. Position of the USPTO contains contradictory statements

Claim 30 recites “said value of said at least one parameter is determined by said incoming MIDI control signal.” Applicant finds the rejection to this element confusing since the record is not clear as to what component of Suzuki is being used to teach a “MIDI control signal,” or the claimed “parameter.” For instance, the Examiner first indicates that generator 11 teaches an “incoming MIDI control signal.” (Office Action of 8/25/06, pg. 2; and Interview Summary of 7/12/06). The Examiner then states that this identical incoming MIDI control signal is taught by controller 13. (Office Action of 8/25/06, pg. 2).

To further confuse matters, the Examiner also alleges in the Interview Summary of 7/12/06 that the claimed “parameter” is generated based upon “both performance event and tone color information” (i.e., input from generators 11 and 12) (emphasis added). This statement contradicts the Office Action of 8/25/06 which states that this same “parameter” is determined by the so-called MIDI control signal from generator 11; the Action makes no mention of the involvement of generator 12. These inconsistencies prevent Applicant an opportunity to fully respond to the various rejections.

5. Conclusion with regard to Suzuki

In view of the foregoing, Suzuki fails to teach or suggest many features recited in independent claim 30, and therefore this claim is believed to be patentable. Independent claim 40 is also believed to be patentable for similar reasons. In addition, dependent claims 31-39, 41, and 42 would be patentable at least by virtue of their respective dependencies on the patentable independent claims.

6. Unjustified prosecution delay-- Sgroi does not teach incoming MIDI control signals

In the 9th and 10th Office Actions of 1/11/06 and 8/25/06, respectively, the Examiner rejects claims 43-60 under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Sgroi. In these Actions, the Examiner once again relies upon Sgroi as teaching the claimed first and second incoming MIDI control signals.

The stated rejections are concerning since Applicant has personally discussed, at great length, the Sgroi patent with the Examiner. It has long been settled in the drawn out prosecution of the present application that Sgroi does not provide the required MIDI control signals. For instance, in Office Actions 6-8, the Examiner explicitly acknowledged that Sgroi does not provide the requisite MIDI input. See Office Actions of 7/27/04 (pg. 4), 1/13/05 (pg. 4), 7/7/05 (Pg. 6); see also the Office Action of 9/2/03 (pg. 5), and the Int. Summary of 6/25/03. The record is replete with reasons why Sgroi does

not provide the required MIDI signals. (See, e.g., Response of 5/17/04, pgs. 14-16; and Response of 5/9/03, pgs. 2-5). The record contains absolutely no support for the latest position offered by the Examiner. Of further concern is that Applicant commented on the Sgroi issue in the Response of 6/12/06, pgs. 18 and 19, but the Examiner never provided a response.

7. Suzuki does not provide MIDI and multiplication is not “fast adding”

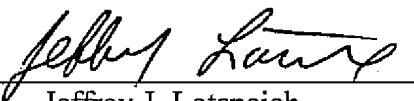
Page 19 of the Response of 6/12/06 also provides reasons why Suzuki cannot teach the various “MIDI control signal” limitations recited in independent claims 43, 46, 49, and 51-57. In addition, the Examiner has never specifically refuted Applicant’s position on this point. (See Office Action of 8/25/06, pgs. 7 and 8). With regard to claim 43, the Examiner maintains the notion that multiplication is “fast adding.” (Office Action of 1/11/06, pg. 6). Not only does Suzuki fail to teach such a concept, Applicant is unaware of any reference which supports such an idea. (Response of 6/12/06, pg. 21).

8. Rejection does not address claims 51-60

Applicant has carefully reviewed the last two Office Actions and is unable to identify any discussion with regard to many claim elements of claims 51-60. Specific deficiencies are noted on pages 21-22 of the Response of 6/12/06. Applicant’s point on these claims is that the Action is deficient since it fails to fully state the rejection to the claims, thus depriving Applicant a fair opportunity to respond. Note further that in the 10th Office Action of 8/25/06, the Examiner never addresses Applicant’s comments on these claims. (See Office Action of 8/25/06, pgs. 7-8).

In light of the above remarks, Applicant submits that the present application is in condition for allowance and requests a Notice of Allowance. The undersigned attorney is available at (213) 623-2221 to discuss any matter concerning this application.

Respectfully submitted,
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